

### REMARKS

Applicants previously presented claims 47-68 for examination. The above-identified Office Action rejected claims 47-51, 53-58, 60 and 62-68, and withdrew dependent claims 52, 59, 61, 65 and 67 from consideration. For the reasons to be stated below, however, Applicants respectfully traverse the Examiner's rejection.

Applicants would also like to thank the Examiner and the Examiner's supervisor for granting an interview to Applicants on February 5<sup>th</sup> and February 6<sup>th</sup>. During the interviews, both parties did not agree on whether MC&S (to be defined below) teaches the features of claim 47. However, Applicants have gained a much better understanding of the rejections in the Office Action, and have agreed to submit the current remarks to clarify any ambiguity.

In this Reply, to expedite the prosecution, Applicants have withdrawn dependent claims 52, 59, 61, 65 and 67 from consideration. Accordingly, claims 47-51, 53-58, 60 and 62-68 remain pending. Applicants respectfully request that the Examiner reconsider the application in light of the remarks expressed herein.

#### Election/Restriction

The Office Action withdrew dependent claims 52, 59, 61, 65 and 67 from consideration. Applicants have accepted the restriction requirement, though Applicants disagree with the requirement because the requirement is not necessary, is not proper, and is prejudicial to Applicants.

The restriction requirement unnecessarily and substantially prejudices and burdens Applicants. Applicants filed this application in 2003, more than 5 years ago. Applicants submit that though a number of prior rejections were unreasonable, yet to expedite the prosecution, Applicants have made a number of amendments, even cancelling, without prejudice and disclaimer, a number of prior pending claims.

If the restriction requirement is to be maintained, Applicants' filing of at least one additional divisional application to cover the restricted claims probably would take another 2 or 3 (or more) years before a first Office Action issues. With the patent period being fixed at 20 years from the priority date, and with technologies moving at a very fast

pace, the restriction requirement places substantial burdens on Applicants by reducing Applicants patent term on those claims. Additionally, Applicants may lose significant amounts of licensing fees and/or damages, should infringement of non-elected claims occur prior to issuance of the divisional application that may be filed in response to the restriction requirement. Moreover, if Applicants are required to file the divisional application, paying of additional filing fee, issue fee, and maintenance fees would create significant financial burdens on Applicants.

From another perspective, under MPEP § 803, "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." A restriction requirement is proper only if there would be a serious burden on the examiner if restriction is not required. MPEP § 803 further explains that, "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant."

Applicants submit that the Office Action has not satisfied the *prima facie* showing that the restriction is proper. First of all, the Office Action has not separately classified the proposed restricted claims, and has not indicated the claims fall under a different field of search. Second, MPEP § 808.02 states that "[s]eparate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search." The Office Action has not cited any patents as evidence of separate status in the art regarding the proposed restricted claims. "Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions." MPEP § 808.02.

Based on the above remarks, Applicants respectfully assert that the restriction requirement is unnecessary, improper, and seriously prejudicial to and burdensome on Applicants. Thus, though Applicants have accepted the restriction requirement, Applicants respectfully request that the restriction requirement be withdrawn, and that all the claims be examined.

### Amending the Specification

This application is a continuation-in-part application of U.S. Pat. No. 5,779,486, entitled, "Methods and apparatus to assess and enhance a student's understanding in a subject," (hereinafter the '486 patent) which has been incorporated by reference into the present application. Regarding amending the specification, a new Figure 8 has been added, which is the same as Figure 6 of the '486 patent. Also, a number of paragraphs have also been added, which are from line 37, col. 8 to line 32 of col. 9 of the '486 patent. Thus no new matter has been introduced. Applicants respectfully request that the amendments to the specification be entered.

### 102 and 103 Rejections

Claims 47-51, 53-58, 60 and 62-68 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by MC&S, or in the alternative, under 35 U.S.C. 103(a) as allegedly being obvious in view of MC&S. The Office Action did not provide any citation for MC&S. However, Applicants presume "MC&S" is the reference with the same abbreviation used in a prior Office Action dated March 17, 2008, which is Success Maker Math Concepts and Skills, Teacher's Handbook, Computer Curriculum Corporation, February 1993. Based on this presumption, for at least the reasons set forth below, Applicants respectfully disagree with the rejections.

### Claims 47, 57 and 63

MC&S does not teach or suggest determining, based on at least 2 rules having a conflict in view of an assessment of the user, which additional materials to present to the user

The Office Action alleged that page 12 of MC&S regarding "presentation of strands" teaches retrieving at least 2 rules to determine which additional materials to present to the user. The argument is that "rules for giving specific strands include but not limited to grade level and understanding of the material". Applicants respectfully disagree.

On its page 12, MC&S discusses its Toolbox and Student Report. The Toolbox "contains rulers, protractors, and a calculator" for a student to use. The Student Report

"provides a representation of the student's performance in the current session." There is no teaching or suggestion regarding any rules on page 12 of MC&S.

It is not clear how MC&S selects specific strands for the student. But the selection seems to be based on the student's performance, or whether the student has reached a certain grade level. This conclusion is supported, for example, by the last paragraph on page 7 of MC&S, which states that, "The system adds or drops appropriate strands as students move through the grade levels. Strands are added as the student reaches the grade level at which these strands begin and dropped as the student reaches the grade level at which these strands end."

MC&S does not teach or suggest rules having a conflict in view of an assessment of the user

Based on the discussion during Examiner Interview, the Office Action may be alleging that MC&S teaches conflict resolution because under a certain condition, a student would be studying certain types of materials, and under another condition, the student would be studying other materials, such as suggested on p. 19 of MC&S. On that page, MC&S recites that, "On occasion the IPM process shows a gain or loss of 2.00 or greater. In such a case, the student should be reenrolled with IPM on." Applicants respectfully disagree with such characterization.

In MC&S, Applicants submit that once a condition is met, the materials for the student would be set. In other words, once a condition is satisfied, the consequence would be fixed. Or to put it in "if A then B" format, once "A" is met, the student would get "B" under all conditions. But MC&S does not teach or suggest, for example, how to resolve situations where at least two conditions are simultaneously met, but the two conditions produce different or even contradictory outcomes.

One example of conflicts as taught in Applicants' specification is as follows:

Rule 1: If a student is weak in algebra, then the student is weak in geometry.

Rule 2: If a student is weak in geometry, then the student is weak in trigonometry.

Based on the two rules, if a student is weak in algebra, the student is weak in trigonometry. Conversely, if a student is strong in trigonometry, the student is strong in

algebra. However, the student's overall scores indicate that the student is strong in trigonometry, but weak in algebra. Thus, the two rules have a conflict in view of the student's overall scores. There are no such teachings or suggestions in MC&S.

MC&S does not teach or suggest having the conflict resolved to determine which additional materials to present to the user

With MC&S not teaching or suggesting at least 2 rules having a conflict in view of an assessment of the user, MC&S could not possibly have taught or suggested having the conflict resolved, let alone having the conflict resolved to determine which additional materials to present to the user.

Looking at the example shown above, one way to resolve the conflict, as taught in the present application, is to disable rule 1 for this student. Without rule 1, no inference can be formed that if a student is strong in trigonometry, the student is strong in algebra. With no such inferences, rule 2 alone is not in conflict in view of the overall scores. MC&S provides no such teachings or suggestions.

For at least the reasons set forth above, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of independent claims 47, 57 and 63. Dependent claims 48-51, 53-56, 58, 60, 62, and 64-68 depend from and add additional features to their corresponding independent claims 47, 57 and 63. Applicants assert that these claims are patentable for at least the reasons discussed above with regards to the independent claims, as well as for the features that they add.

Thus Applicants submit that claims 47-51, 53-58, 60 and 62-68 are patentable over MC&S and any other art of record. Further the independent or the dependent claims recite additional elements which when taken in the context of the claimed invention further patentably distinguish from the art of record. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from the art of record. Thus, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 47-51, 53-58, 60 and 62-68 under 35 USC 102(b) and 103(a).

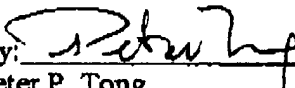
Summary

It is submitted that claims 47-51, 53-58, 60 and 62-68 are patentably distinct from the art of record. Reconsideration of the application and an early Notice of Allowance are earnestly solicited.

In the event that the Examiner, upon reconsideration, determines that an action other than an allowance is appropriate, the Examiner is requested and authorized to telephone Applicants' representative prior to taking such action, if the Examiner feels that such a telephone call will advance the prosecution of the present application.

Any required fee in connection with the filing of this response is to be charged to Deposit Account No. 50-0727.

Respectfully submitted,

By:   
Peter P. Tong  
Registration No.: 35,757  
1807 Limetree Lane  
Mountain View, CA 94040  
(650) 625-8192